



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

915-007.127

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on September 17, 2009

Signature _____

Typed or printed name Lissette Ramos

Application Number

10/523,543

Filed

January 31, 2005

First Named Inventor

J. HAKUNTI, et al.

Art Unit

1795

Examiner

Jacob B. MARKS

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.


The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 27,550☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Alfred A. Fressola
Typed or printed name

(203) 261-1234

Telephone number

September 17, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of One forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT
Attorney Docket No. 915-007.127

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application Of:

Jussi HAKUNTI, et al.

: Confirmation No.: **7526**

Application Serial No.: **10/523,543**

: Group/Art Unit: **1795**

Filing Date: **September 22, 2005**

: Examiner: **Jacob B. MARKS**

Title: ***Battery Holder***

Mail Stop: AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

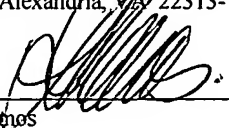
Sir:

This Request for Review is filed in response to the final Office Action of June 17, 2009 and the Advisory Action of August 28, 2009.

Claims 1-11 were examined by the Office and claims 1-11 were rejected. Applicant respectfully requests review of the final rejection of the claims in view of the following discussion. The Office is believed to have committed clear error by failing to establish that the cited references, Law, et al (US patent 5,733,674) (hereinafter Law) in view of Redford (US patent 5,763,112) suggest claims 1-11.

This Pre-Appeal Brief Request for Review is being submitted together with a Notice of Appeal.

I hereby certify that this communication is being deposited with the United States Postal Service today, September 17, 2009, in an envelope with sufficient postage as first-class mail addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Lissette Ramos

REMARKS

Overview of the Present Invention

The present invention is directed to a battery holder 30 for assembly with an electronic device having a cover 10 as shown in Figures 1-4 of the present application. It is directed to such a battery holder comprising an outer surface 31, guiding elements 32 configured to receive at least one exchangeable battery at a side opposite to the outer surface, and a projection 33 and a connection 34 configured to connect the battery holder releasably to the electronic device such that electrical contact elements of the battery received by the battery holder come into contact with the electrical contact elements of the electronic device and further such that the outer surface 31 of the battery holder forms part of the outer surface of the electronic device 10.

Claim Rejections - 35 USC §103

Section 4 of the final Official Action rejects claim 1-11 under 35 USC §103(a) as unpatentable over Law in view of Redford. With respect to claim 1, the Office asserts that Law teaches a battery holder having elements corresponding to those recited in claim 1 except that it does not teach that the electrical contact elements of at least one battery received by said battery holder come into contact with the electrical elements of the electronic device. The Office asserts that Redford teaches that a conventional electrical device may have a battery cover wherein the electrical contact of at least one battery comes into direct contact with an electronic device, citing Figure 1, terminals 108 and 109 of Redford. Applicant respectfully disagrees.

The Cited Art

Law is directed to a power supply system as best seen in Figures 1-3. It includes a battery holder (container assembly) 26 which includes a case 30 having walls 46-54. Law includes guiding members (flanges) 68 and 70 that are formed on a cover member 34 as best seen in Figure 3. These flanges are to align the negative end 60 and positive end 62 of battery 40 with the terminals 56 and 58 of the battery holder (container assembly 26). It is therefore clear that the terminals 56 and 58 do not come into contact with electrical contact elements of the electronic device (telephone) 22 (see Figure 1) to which the battery holder can mate, since it is terminals 76 and 80 of the battery holder which make contact with the electronic device 22, as clearly illustrated in Figure 5.

Redford is directed to a stick-on peel-off fastener. The Office relies upon Figures 1B and 1C showing prior art in which an enclosure 102 includes a positive terminal 108 and a negative terminal 109 for connection to batteries 110 and 120 inserted within enclosure 102 forming part of electrical device 100.

Argument

The Office asserts that since Redford shows an electrical device having terminals 108 and 109 for direct receipt of batteries, that it would be obvious to combine such terminals to teach direct electrical contact of at least one battery in the battery holder of Law with an electronic device to which the battery holder releasably connects to. This argument is respectfully refuted since a device that receives one or more batteries directly as shown by Redford cannot possibly provide a suggestion as to how to configure a battery holder even if such a device discloses that the battery or batteries may come directly into contact with the terminals of the device. In fact, using a battery holder, such as that shown in Law, is exactly an alternative approach to the approach of inserting one or more batteries directly into a device as shown by Redford.

In particular, Law specifically shows that its battery holder 26 includes a plurality of terminals 56 and 58 for contact with terminals 60 and 62 of batteries 40. Separate terminals 76 and 80 are provided for making electrical contact between this battery holder 26 and the electronic device 22 to which it can mate as illustrated in Figure 1. There is absolutely no suggestion as to how the batteries 40 shown in Law could make electrical contact with electrical contacts of device 22 and clearly the use of terminals 108 and 109 of Redford do not provide any suggestion as to how to modify any of the terminals in Law so as to provide that electrical contact elements of at least one battery received by said battery holder come into contact with electrical contact elements of said electronic device 22 (see Figure 1 of Law).

In short, Law teaches one approach for placing batteries in a battery holder with separate and distinct electrical contacts 76 and 80 for making electrical contact with device 22 when the battery holder is mated with the device and separate electrical terminals 56 and 58 for making electrical contact with terminals 60 and 62 of the batteries within the battery holder, while Redford teaches the use of terminals inside a device for accepting batteries within the device itself.

Contrary to the position taken by the Office, the terminals in Redford are not a simple substitution for the terminals of the battery holder shown in Law and therefore it would not be

obvious to a person of ordinary skill in the art to make a substitution of the terminals in Redford with the terminals in Law.

MPEP §2143 provides that the simple substitution of one known element for another to obtain predictable results may provide for a *prima facie* case of obviousness. However, the rationale enunciated in MPEP §2143 is that to support a conclusion that a claim would have been obvious is that the substitution of one known element for another yields predictable results to one of ordinary skill in the art. In the present situation, it is not seen how one of ordinary skill in the art would take the electrical terminals 108 and 109 in Redford and substitute them for any of the electrical terminals in Law. In fact, if the electrical terminals 108 and 109 are substituted for electrical terminals 76 and 80 in Law used to make electrical connection between the battery holder 26 and device 22 (see Figures 3 and 5 of Law), they would provide the same functionality that terminals 76 and 80 already provide between the battery holder 26 and device 22. If it is argued that terminals 108 and 109 of Redford could be substituted for terminals 56 and 58 of Law, then they would provide the same functionality as terminals 56 and 58 of Law; i.e., to make electrical contact between the batteries and terminals 56 and 58 within the battery holder with no provision as to how such terminals 56 and 58 could then possibly be part of the electronic device 22 since the battery holder as shown in Law is clearly designed to be separable from the electronic device 22.

Consequently, it is respectfully submitted that the Office has not shown that the substitution of the terminals in Redford would result in a known and predictable result with regard to the battery holder shown in Law.

The Office in the Advisory Action states that claims 1 and 11 do not recite the limitation that the contact is made while the battery holder is being connected to the device. However, it is specifically noted in claims 1 and 11 that the battery holder releasably connects to an electronic device such that electrical contact elements of at least one battery received by said battery holder come into contact with electrical contact elements of said device and such that said outer surface of said battery holder forms part of the outer surface of said electronic device. Such a configuration makes clear that the electrical contact elements of the at least one battery come into contact with the electrical contact elements of the electronic device as the outer surface of the battery holder forms part of the outer surface of said electronic device. The contention by the Office is therefore respectfully refuted.

The present invention thereby presents a new and unobvious manner in which the battery holder is configured to receive at least one battery such that the electrical contact elements of the at least one battery received in the battery holder come into contact with electrical contact elements of the electronic device. It is therefore respectfully submitted that the battery holder recited in claim 1 is not suggested by a combination of Law and Redford.

Independent claim 11 is also directed to a battery holder having features corresponding to those recited above with respect to claim 1, but using means plus function terminology as provided for under 35 USC §112, sixth paragraph. For similar reasons as those presented above with respect to claim 1, it is respectfully submitted that claim 11 is also not suggested by a combination of Law and Redford.

Dependent claims 2-10 all ultimately depend from claim 1 and are believed to be allowable at least in view of their dependency from claim 1.

Conclusion

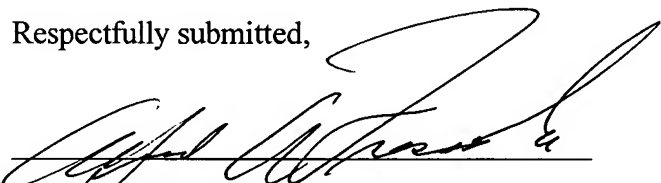
For all of the foregoing reasons, it is respectfully submitted that the rejection of the final Office Action has been shown to be inapplicable and therefore withdrawal thereof is requested and passage to issue of the present application is earnestly solicited.

The undersigned hereby authorizes the Commissioner to charge deposit account 23-0442 for any fee deficiency required to submit this response.

Dated: September 17, 2009

WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, CT 06468
Telephone: (203) 261-1234
Facsimile: (203) 261-5676
USPTO Customer No. 004955

Respectfully submitted,



Alfred A. Fressola
Attorney for Applicant
Registration No. 27,550